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APPLICATION NUMBER	FILED DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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09/235,242 01/22/99 FRIEDRICH

W 48746

EXAMINER

HM12/1117

KEIL & WEINKAUF  
1101 CONNECTICUT AVENUE N W  
WASHINGTON DC 20036

STOCKTON	PAPER NUMBER
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1613

DATE MAILED:

11/17/99

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

## OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on November 9, 1999☐ This action is FINAL.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.A shortened statutory period for response to this action is set to expire 3 month(s), ~~or that longer~~ whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

- ☒ Claim(s) 2-6 are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 2-6 are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

09/235,242

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## **DETAILED ACTION**

Claims 2-6 are pending in the application.

### ***Continued Prosecution Application***

1. The request filed on November 9, 1999 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/235,242 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Response to Amendment***

2. The change to claim 6 as directed per Amendment B filed October 4, 1999 was not entered because Applicants did not indicate where on the second to the last line from the bottom of the claim should the phrase "at from 50 to 250 °C" was to be added {ie., at the beginning of the line? or in the middle of the line? or at the end of the line?}.

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***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "A PROCESS OF MAKING  $\gamma$ -ALKOXY**AMINES**" instead of " $\gamma$ -ALKOXY**NITRILES**" (see page 21, lines 20-36 or instant claim 6).

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

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the invention. In claim 6, "basic catalysts" and " $\beta$ -alkoxynitriles" should be singularized.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green {U.S. Pat. 4,617,154} in view of Sullivan, III et al. {U.S. Pat. 4,231,956} and O'Lenick, Jr. et al. {U.S. Pat. 5,196,589}.

Applicants claim a process of making a  $\gamma$ -alkoxyamine by reacting an  $\alpha,\beta$ -unsaturated nitrile with an alcohol in the presence

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of a basic catalyst (ie., a diazabicycloalkene catalyst) to form a  $\beta$ -alkoxynitrile followed by hydrogenation of the  $\beta$ -alkoxynitrile in the presence of a hydrogenation catalyst (ie., Raney nickel) to obtain a  $\gamma$ -alkoxyamine.

Green teaches a process of making a  $\beta$ -alkoxynitrile and a  $\beta$ -alkylthionitrile by reacting an  $\alpha,\beta$ -unsaturated nitrile with an alcohol in the presence of a diazabicycloalkene catalyst (see columns 1 and 2). Further, Sullivan, III et al. teach additional diazabicycloalkene catalysts useful in the preparation of a  $\beta$ -alkylthionitrile (column 5, lines 13-25). O'Lenick, Jr. et al. teach a process of making a  $\beta$ -alkoxynitrile by reacting an  $\alpha,\beta$ -unsaturated nitrile with an alcohol (see column 2). O'Lenick, Jr. et al. further teach that a  $\beta$ -alkoxynitrile (the products also taught by Green and Sullivan, III) can undergo a hydrogenation process in the presence of a suitable catalyst (ie., Raney nickel) to form a  $\gamma$ -alkoxyamine (column 2, lines 1-9 and column 4, lines 48-53).

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The claimed process is no more than a selective combination of prior art teachings done in a manner obvious to one of ordinary skill in the art since each step of the process appears to be relatively complete in itself and there is no indication of an interaction between steps of such a type that would lead one of ordinary skill in the art to doubt that a substitution of alternative steps known to the art could be made. *In re Mostovych*, 144 USPQ 38 (1964).

One skilled in the art would have been motivated to utilize the process of Green, especially in view of the teachings of Sullivan, III et al. and O'Lenick, Jr. et al., to arrive at the instant claimed process with the expectation of obtaining a  $\gamma$ -alkoxyamine. Therefore, the claimed process would have been suggested to one skilled in the art.

Applicants argue that original claim 6 is directed to a process of preparing  $\gamma$ -alkoxynitriles and that the Examiner's rejection

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which relies upon prior art which relates to the preparation of  $\beta$ -alkoxynitriles is inapt.

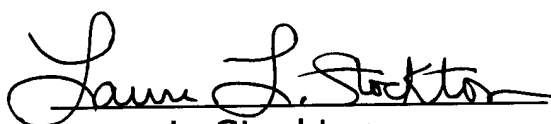
In response, Applicants are in error because claim 6, the independent claim, is directed to a process of making a  $\gamma$ -alkoxyamine and not a process of making  $\gamma$ -alkoxynitrile (see instant claim 6 and the instant specification on page 21, lines 24-40). Further, as noted above, the combination of the cited prior art references teach Applicants' claimed process of making a  $\gamma$ -alkoxyamine.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

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A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or 305-3592.

A handwritten signature in cursive script, reading "Laura L. Stockton".

Laura L. Stockton

Patent Examiner

Art Unit 1613, Group 1610

Technology Center 1

November 16, 1999